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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,512	10/25/2002	Carl Michael Dennison	BLD920010033	2133

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IBM CORPORATION
PO BOX 12195
DEPT 9CCA, BLDG 002
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

BEATTY, ROBERT B

ART UNIT	PAPER NUMBER
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2852

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/065,512	Applicant(s) DENNISON ET AL.	
	Examiner Robert Beatty	Art Unit 2852	<i>AW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilekelmann et al. (EPA# 864,933) in view of Nakagiri et al. (EP# 1,098,266).

Schilekelmann et al. teach a reproduction apparatus having an image data input means such as scanning means 2902 or external machine 2910 which are stored in a memory means 2903, a display means 2907, a printing means 2904 for printing the images onto paper sheets, and a control means (having computer readable storage medium) 2905 for controlling all aspects of the reproduction apparatus via instructional operation. See Fig. 29. Referring to Fig.10, a display screen 210 (which is part of the display means 2907) displays a sequence of pages 1012 present in a print job. An indicator symbol 1011 can be moved through the sequence of pages to a desired point and a sheet can be inserted at that point. A blank sheet can be added via button 1007, an intermediate sheet can be added via button 1105 (Fig.11), or a page in the sequence of pages can be deleted via button 1008. As shown, page 21 has been marked such that this sheet was added or is marked for deletion. In addition, a series of pages can be marked. If the print job

had already been scanned, reduced versions of these pages can be displayed. An enlarged version of a selected page can be viewed on another part of the display. See col. 10, line 15 – col.11, line 5. The reproduction apparatus will print the print job as modified by the display (e.g. a cover sheet will be inserted) however, the original print job is not altered. As seen Fig.3, the option of inserting a cover sheet in the back or front of the print job can be selected via button 303. The control means 2905 will perform instructions so as to perform a copy operation. Specifically, Schilekelmann et al. teach everything claimed except actually displaying the insert sheet or a cover (preprinted) sheet in plurality along with the print sheets of the print job on the display means.

Nakagiri et al. teach a reproduction apparatus for printing a print job composed of a plurality of print sheets and of inserting either cover sheets or inserts into the middle of the print job. These print sheets will be displayed on a display means. As seen in Fig.35, for example, the cover sheet can be displayed along with the print job sheets. Additionally, insert sheets that are inserted into the middle of the print job can be displayed as well (see col. 35, lines 15-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to display inserted cover sheets or inserted middle sheets in a print job because visual confirmation of the output result can be obtained before committing to an actual print operation. It would have been further obvious to one of ordinary skill in the art at the time the invention was made to display the insert sheets in plurality since

the need for a printjob having both a cover sheet and a middle insert sheet is encompassed by the operation of both the Schilekelmann et al. and Nakagiri devices and such display would again ease the operator's mind via visual confirmation before committing to an actual print operation.

2. Applicant's arguments filed 11/20/2003 have been fully considered but they are not persuasive.

Applicant has amended the claims to include the limitation that the print job is not altered. Applicant argues that EPA '933 teach altering the source file (print job) with the alternate pages (blank pages, cover sheets, inserted graphics, etc) to create a new source file. The applicant, in contrast, never saves the alternate pages with the source file (print job) and therefore does not "alter" the (original) print job. The placement of the alternate pages are saved in an associated job ticket.

However, it is not seen in EPA '933 that the (original) print job has been altered (and saved). As seen in Fig. 10, the print job is displayed on a display screen. If an alternate page is to be inserted somewhere in the print job it is so indicated on the display screen (col.11, lines 2-5). EPA '933 does not describe altering (permanently) the source file (print job), only indicating on a display where the user would want an alternate sheet to be inserted. Therefore, the examiner believes EPA '933 teach not altering the original print job (which is displayed on a

display screen as in Fig.10) but only indicating where an alternate sheet is to be placed.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

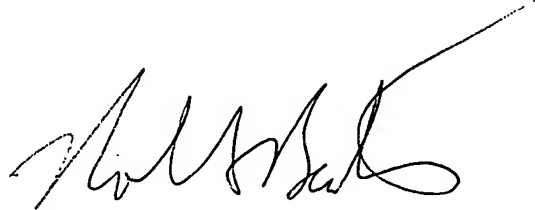
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Beatty whose telephone number is 703-308-1372. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley, can be reached on (703) 308-1373. The fax

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phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

A handwritten signature in black ink, appearing to read 'Robert Beatty', with a long, sweeping horizontal stroke extending to the right.

Robert Beatty
Primary Examiner
Art Unit 2852

January 30, 2004